

## REMARKS

By virtue of this amendment claim 1-9 and 12-20 are pending in this application. The recitations of claims 10 and 11 have been incorporated into claims 1 and 16. No new matter has been added as a result of this amendment.

In a February 24, 2006 Office Action, the period for which to respond extends until May 24, 2006, the Examiner rejected the claims 1, 2, 4-6, and 8-20 under 35 U.S.C. § 102(b) as being anticipated by United States Patent 2,596,894 (“Frisch”). The Examiner rejected claims 1-7 and 10-20 under 35 U.S.C. § 102(b) as being anticipated by United States Patent 5,685,791 (“Feeney”). The applicants respectfully traverse the rejections.

### Regarding the rejection under 35 U.S.C. § 102(b) to Frisch

The Examiner rejected claims 1, 2, 4-6, and 8-20 under 35 U.S.C. § 102(b) as being unpatentable over Frisch. The applicants respectfully traverse the rejection.

Claim 1 has been amended and recites a combination of elements including, for example, “at least one tapered portion in the shaft; and at least one expanding portion in the shaft,” which is not disclosed by the references. The Examiner appears to agree that Frisch does not disclose a tapered portion and an expanding portion in the shaft as the Examiner seems to rely on a portion of the head associated with the Frisch stick. Moreover, as one of ordinary skill in the art would recognize, the portion of Frisch does not show a tapered and expanding section, but rather an offset shape necessary to provide the smooth curved section of the sidewalls associated with the head. Noticably, the overall diameter or thickness of the curved sections remains relatively consistent with the diameter of the or thickness of the straighter sections of the head sidewalls. Conversely, as shown by Figures 2 and 3 of the present invention, the expanding portion 222 and tapered portion 220 has a larger and smaller diameter or thickness, respectively, as compared to the remained of the shaft. This facilitates flexion of the shaft and grip during the course of play. Thus, even if Frisch did disclose a narrowing/widening diameter or thickness in the head portion, the narrowing/widening is solely to facilitate the smooth molding and has nothing to

do with game play. As it has nothing to do with game play, it would be unnecessary to apply the design of the head sidewalls to the shaft. Thus, for at least this reason, amended claim 1 is not anticipate by Frisch.

Regarding claim 16, claim 16 recites a combination of elements including, for example, “a shaft with an integrated end stop molded to the shaft,” which is not disclosed by Frisch. In fact, the Examiner completely ignores the structural differences between claim 1 and 16 in the rejection and simply refers to the claim 1 rejection when rejecting claim 16. Claim 16, however, recites “an integrated end stop molded to the shaft.” Whereas claim 1 does not recite any structure associated with the end stop. For at least this reason, the Examiner’s rejection of claim 16 is in error. Moreover, Frisch while arguably showing the shaft 4 has an end stop it is completely silent regarding “an integrated end stop molded to the shaft.” Thus, even if the Examiner had properly recognized the end stop, Frisch would still fail to anticipate claim 16 because it is silent regarding the connection between the end stop and the shaft. Thus, for at least this reason, claim 16 is not anticipated by Frisch.

Based on the above, as amended claims 1 and 16 are not anticipated or obvious in view of Frisch, withdrawal of the pending rejection to Frisch is respectfully requested. Claims 2-9, 12-15, and 17-20 depend directly or indirectly from claims 1 and 16 and, at least by virtue of the dependency are not anticipated or obvious in view of Frisch, withdrawal of the pending rejection to Frisch is respectfully requested.

Regarding the rejection under 35 U.S.C. § 102(b) to Feeney

The Examiner rejected claims 1-7 and 10-20 under 35 U.S.C. § 102(b) as being unpatentable over Feeney. The applicants respectfully traverse the rejection.

Claim 1 has been amended and recites a combination of elements including, for example, “at least one tapered portion in the shaft; and at least one expanding portion in the shaft,” which is not disclosed by the references. The Examiner appears to agree that Feeney does not disclose a tapered portion and an expanding portion in the shaft as the Examiner seems to rely on a portion of the

head/shaft junction associated with the Feeney stick. Moreover, as one of ordinary skill in the art would recognize, the portion of Feeney does not show a tapered and expanding section, but rather at most either a tapered portion or expanding section to accommodate the transition from the junction to the ball stop associated with the head. Noticeably, the overall diameter or thickness of the shaft sections remains relatively consistent with the diameter of the or thickness of the straighter sections of the head sidewalls. Conversely, as shown by Figures 2 and 3 of the present invention, the expanding portion 222 and tapered portion 220 has a larger and smaller diameter or thickness, respectively, as compared to the remained of the shaft. This facilitates flexion of the shaft and grip during the course of play. Thus, for at least this reason, amended claim 1 is not anticipate by Feeney.

Regarding claim 16, claim 16 recites a combination of elements including, for example, “a shaft with an integrated end stop molded to the shaft,” which is not disclosed by Feeney. In fact, Feeney does not even disclose an end stop however attached to the shaft. Thus, it is completely impossible for Feeney to anticipate claim 16. Thus, for at least this reason, claim 16 is not anticipated by Feeney.

Based on the above, as amended claim 1 and claim 16 are not anticipated or obvious in view of Feeney, withdrawal of the pending rejection to Feeney is respectfully requested. Claims 2-9, 12-15, and 17-20 depend directly or indirectly from claims 1 and 16 and, at least by virtue of the dependency are not anticipated or obvious in view of Feeney, withdrawal of the pending rejection to Feeney is respectfully requested.

#### Reliance on Section 2112

The Examiner’s reliance on section 2112 to reject claims 2, 4-6, 8, 9, 12-15 and 17-20 seems misplaced by the statement that the references are “capable” of certain features. However, under the guidance of section 2112: “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient . . .” (MPEP 2112 (emphasis in original)). Rather, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or

technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (*Id.* (emphasis in original)). In this case, the Examiner states no more than the mere fact that the lacrosse stick could have been designed in a particular way should someone have chosen to design it that way. This is clearly insufficient under the standard of proof required by the section. Absent the present application, no reasons existed in the prior art to provide the designs disclosed by the specification and claimed by the applicants. To the Extent the Examiner maintains the rejections under section 2112, the applicants respectfully request the Examiner to supplement the rejection with explicit references or reasoning. Thus, for at least this additional reason, claims 2, 4-6, 8, 9, 12-15 and 17-20 are not anticipated by either Frish or Feeney.

Based on the foregoing, reconsideration and allowance of claims 1-9 and 12-20 of the application is respectfully requested.

If an extension of time under 35 C.F.R. § 1.136 is required to obtain entry of this Amendment, such an extension is requested. If there are fees due under 37 U.S.C. §§ 1.16 or 1.17 which are not otherwise accounted for, please charge our Deposit Account No. 08-2623.

Respectfully submitted,



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